

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 5, 8, 10, and 17 were previously canceled. No claims are being added.

Claim 1 is currently amended. Support for the amendment can be found in the specification, for example, at paragraph [0015].

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-4, 6-7, 9, 11-16, and 18-20 are now pending in this application. Claims 1-4 and 6-7 are under examination.

I. Claim Rejections Under 35 U.S.C. § 103(a) Over Applicants' 131 Declaration

The PTO rejected claims 1-4, and 6-7 as being obvious over Applicants' admission in their 131 Declaration. (Office Action, page 2) Applicants respectfully traverse the rejections.

To establish a *prima facie* case of obviousness, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 82 U.S.P.Q.2d 1385 (2007). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144.

The PTO stated that the papers filed by Applicants admit that the base paper and the ink receptive coating were known. Even assuming such a statement to be true (which Applicants do not concede), the PTO has not shown any reason that would have prompted one skilled in the art to combine the known elements. The PTO stated "[b]ased upon this admission, it would have been obvious to one of ordinary skill in the art to coat the commercially available base paper with a known ink receptive composition at a conventional coating weight in order to obtain an ink receptive medium." However, this statement does

not provide a requisite reason for combining the elements in a manner as claimed, rather is based on improper hindsight.

Applicants respectfully submit that the rejection based on the 131 Declaration is improper. Accordingly, they respectfully request the reconsideration and withdrawal of the rejection.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-4, 6 and 7, which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. MPEP § 2143.03. Therefore, the Applicant requests that the reconsideration and withdrawal of the rejection to claims 1-4, 6 and 7.

II. Claim Rejections Under 35 U.S.C. § 103(a) Over Sekiguchi (US 6,485,812) in View of Graumann et al. (EP 0878319)

The PTO rejected claims 1-4 and 6-7 as being obvious over Sekiguchi in view of Graumann et al. (EP 0878319). (Office Action, page 2) Applicants respectfully traverse the rejections.

No *prima facie* case of obviousness against claim 1 as presently amended can be based on Sekiguchi and Graumann.

Sekiguchi specifically teaches a teralkyoxytitanium of formula (1) being a key component and serving as the cross-linking agent in its ink-receiving layer. (Please see col. 7, lines 5-7.) Its teaching is centered on this teralkyoxytitanium of formula (1) as a critical component for producing the desired results. In the amended claim 1, there is no such teralkyoxytitanium compound as a cross-linking agent. Rather it recites other cross-linking agents far different from and not known as substituting equivalents of the teralkyoxytitanium of formula (1). On the other hand, Graumann does not teach or suggest an ink-receiving layer which includes a cross-linking agent. Rather it teaches an ink-absorbing coating that contains an uncrosslinked copolymer (I) of a quaternary ammonium compound and pyrrolidone. (Please see paragraph [0013] and claims.) As such, the teachings of Sekigushi and Graumann cannot be combined in arriving at the present claim 1.

Applicants respectfully submit that the rejection based on Sekiguchi and Graumann is improper. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection to claims 1-4, 6 and 7.

III. Claim Rejections Under 35 U.S.C. § 103(a) over Sekiguchi (US 6,485,812) in View of Graumann et al. (EP 0878319) Further in View of Shih et al. (US 6,780,924) and Koike et al. (US 6,777,039)

The PTO rejected claims 1-4 and 6-7 as being obvious over Sekiguchi (US 6,485,812) in view of Graumann et al. (EP 0878319) and further in view of Shih et al. (US 6,780,924) and Koike et al. (US 6,777,039). (Office Action, page 3) Applicants respectfully traverse the rejections.

Because a *prima facie* case of obviousness cannot be based on Sekiguchi in view of Grauman, there is no *prima facie* case further in view of secondary references, Shih et al. (US 6,780,924) and Koike et al. (US 6,777,039).

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection to claims 1-4, 6 and 7.

IV. Claim Rejections Under 35 U.S.C. § 103(a) Over Sekiguchi (US 6,485,812) in View of Graumann et al. (EP 0878319) Further in View of Nigam et al. (US 6,936,316)

The PTO rejected claims 1-4 and 6-7 as being obvious over Sekiguchi (US 6,485,812) in view of Graumann et al. (EP 0878319) and further in view of Nigam et al. (US 6,936,316). (Office Action, page 4) Applicants respectfully traverse the rejections.

Because a *prima facie* case of obviousness cannot be based on Sekiguchi in view of Grauman, there is no *prima facie* case further in view of secondary reference Nigam et al. (US 6,936,316).

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection to claims 1-4, 6 and 7.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 02-2025. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 02-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 02-2025.

Respectfully submitted,

Date: April 24, 2008

By 

Hewlett-Packard Company
Customer Number: 22879

William T. Ellis
Attorney for Applicants
Registration No. 26,874
Telephone: (202) 672-5485

Qun Liu
Attorney for Applicants
Registration No. 55,392